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Docket No.: PA-0020 US

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By:

Printed: Christopher Turner

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MAY 29 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TECH CENTER 1600/2900

In re Application of: Sornasse et al.

Title: GENES REGULATED BY HUMAN CYTOKINES

Serial No.: 09/435,247

Filing Date: November 5, 1999

Examiner: Prasad, S.

Group Art Unit: 1646

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This is in response to the Restriction Requirement and Request for Election mailed April 20, 2001, setting a 1 month term for response.

Original claims 1-20 were filed. In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Groups 1-516 (claims 1-6, 11-13) drawn to polynucleotides, vectors and host cells thereof, and a plurality of polynucleotides on a substrate.

Groups 516-1032 (claims 1, 7-9) drawn to a plurality of polynucleotides and methods of use.

Groups 1033-1548 (claim 10) drawn to a method of using the polynucleotides to purify ligands.

Groups 1549-1791 (claim 14) drawn to polypeptides.

Groups 1792-2034 (claims 15-17) drawn to methods of using the polypeptides.

Groups 2035-2794 (claims 18-20) drawn to methods of using the plurality of polynucleotides.

Applicants strongly protest the current restriction requirement. First, claim 1 appears in both groups 1-516 and groups 516-1032. Claim 1 is directed to a composition comprising a plurality of polynucleotides. Applicants argue restriction of a plurality of polynucleotides to each single polynucleotide is contrary to normal restriction procedure. As stated in the MPEP, "Applications claiming only a combination of nucleotide sequences ... will generally not be subject to a restriction requirement. The presence of one novel and nonobvious sequence within the combination will render the entire combination allowable. The combination will be searched until one nucleotide sequence is found to be allowable." MPEP § 803.04. Further, claim 6, which depends from claim 1, appears in groups 1-516, but not in groups 516-1032. Also,

group 516 apparently encompasses claims 1-9 and 11-13, whereas groups 1-515 are restricted to claims 1-6 and 11-13, and groups 517-1032 are restricted to claims 1 and 7-9.

Second, the Examiner has required election of a single polynucleotide or polypeptide for examination. Applicants argue the requirement of a single sequence for examination should not be imposed for claims 1, 6-9, and 18-20, which are directed to a plurality of polynucleotides (i.e. a combination) and methods of using the combination (MPEP § 803.04). Further, election of a single species renders restriction to groups 1-516 meaningless. Applicants require clarification of what differences exist between groups 1-516 which are all drawn to claims 1-6 and 11-13. Similar questions exist relative to groups 516-1032, 1033-1548, 1549-1791, 1792-2034, and 2035-2794. For example, what is encompassed by election of group 516? Examiner has not clearly defined the metes and bounds of this group; thus, what Applicants are electing is unclear.

Third, the Examiner has required election of a "species" for ligands recited in claims 9 and 16 and disorders recited in claims 19-20. Applicants point out that claims 9, 16, and 19-20 are directed to methods of using either the plurality of polynucleotides (claims 9 and 19-20) or a polypeptide (claim 16). Claims 9 and 16 identify specific libraries of molecules or compounds that can be used in a screening assay. As the claim is not directed to the library or any specific molecule or compound that may be identified within the library, restriction is inappropriate. Similarly, claims 19 and 20 identify specific disorders that may be diagnosed or monitored using the plurality of polynucleotides.

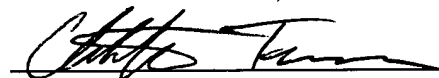
Due to the errors in the restriction requirement and the unclear scope of the groups for election, Applicants request clarification and a new restriction requirement. Applicants also request the time for response be reset to reflect the withdrawal of the current restriction requirement and application of a new restriction requirement.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

This form is enclosed in duplicate.

Date: 21 May 2001

Respectfully submitted,
INCYTE GENOMICS, INC.

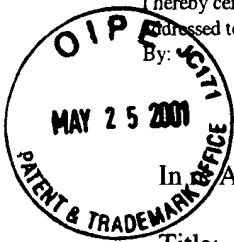


Christopher Turner, Ph.D.

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 By: [Signature] Printed: Christopher Turner

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TECH CENTER 1600/2900

AMENDMENT TRANSMITTAL FEE SHEET

Sir:

Transmitted herewith are the following for the above-identified application:

1. Return postcard; and
2. Response to Restriction Requirement (2 pp., in duplicate).

The fee has been calculated as shown below.

Claims	Claims After Amendment	-	Claims Previously Paid For	=	Present Extra	Other Than Small Entity Rate Fee		Additional Fee(s)
Total Claims	20	-	20	=	0	\$18	0	\$0
Indep. Claims	2	-	3	=	0	\$80	0	\$0
<u> </u> First Presentation of Multiple Dependent Claim						+\$270		\$0

TOTAL \$ 0 X No additional fee is required. Please charge Deposit Account No. 09-0108 the amount of \$ 0

The Commissioner is hereby authorized to charge any additional fees required under 37 CFR 1.16 and 1.17, or credit overpayment to Deposit Account No. 09-0108. A duplicate copy of this sheet is enclosed.

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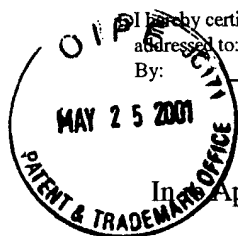
Date: 21 May 2001

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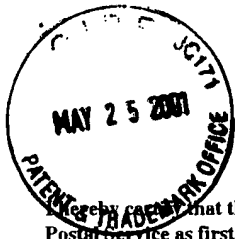
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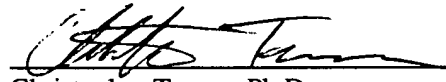
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